

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Sambit Dash Art Unit : 2628
Patent No. : 7,609,278 Examiner : Chante E. Harrison
Issue Date : October 27, 2009 Conf. No. : 4545
Serial No. : 10/633,436
Filed : July 31, 2003
Title : DETECTING BACKWARD MOTION REPRESENTED BY A PATH

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1,223 days to 1,723 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. *Id.*

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before September 30, 2004 (the date that is fourteen months after July 31, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on December 20, 2007, thereby according a PTO Delay of 1,176 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from October 1, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to December 20, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before December 7, 2008 (the date that is four months after August 7, 2008, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on January 23, 2009, thereby according a PTO Delay of 47 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from December 8, 2008 (the day after the date that is four months after the date on which a response to Office Action was filed), to January 23, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 1,223 days (i.e., the sum of 1,176 days and 47 days).

“B Delay”

The period beginning on August 1, 2006 (the day after the date that is three years after July 31, 2003, the date on which the application was filed), and ending October 27, 2009 (the date the patent was issued), is 1,184 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

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In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a non-final Office Action. In the present application, a Notice of Appeal was filed on September 23, 2008, and a non-final Office Action was mailed by the PTO on January 23, 2009, resulting in a period of 123 days that must be excluded from the three year delay calculation.

See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 1,061 days (i.e., 1,184 days minus 123 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 1,061 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of “A Delay” and “B Delay”

As detailed above, “A Delay” accumulated during the following periods:

October 1, 2004, to December 20, 2007; and

December 8, 2008, to January 23, 2009.

As detailed above, “B Delay” accumulated during the following periods:

August 1, 2006, to September 23, 2008; and

January 24, 2009, to October 27, 2009.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 507 days, from August 1, 2006, to December 20, 2007.

Applicant Delay

Patentee filed a Supplemental Reply on June 2, 2009, subsequent to a reply filed on April 9, 2009. No Applicant Delay was accorded for this reply; however, in good faith and candor, Patentee respectfully submits that the Supplemental Reply should have been accorded a total Applicant Delay of 54 days for delay from April 10, 2009, to June 2, 2009.

See 37 C.F.R. § 1.704(c)(8).

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In view of the period of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 54 days.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 1,223 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,777 days (i.e., the sum of 1,223 days of "A Delay" and 1,061 days of "B Delay" minus 507 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 54 days; and
- 3) Total PTA should be calculated as 1,723 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 07844-0601001.

Respectfully submitted,

Date: December 18, 2009

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